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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,429	10/28/2003	David Mathieu	2185.004USU	9460

56080 7590 06/02/2006

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EXAMINER

HAMILTON, ISAAC N

ART UNIT PAPER NUMBER

3724

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,429

Applicant(s)

MATHIEU ET AL.

Examiner

Isaac N. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32, 37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 28-32, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the invention in Group II and Species I in figure 1 in the reply filed on 03/09/2006 is acknowledged.

2. Applicant's election of claims 19-27 in the reply filed on 03/09/06 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 1-18, 28-32 and 37-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 03/09/06.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "34" on page 8, line 22; "67" on page 11, line 22. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 25, 17 and 41. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the actuator integral with the blade carriage such that a portion of thereof can move to position cutting blade 50 with respect to a cutting surface as described in the specification on page 8, lines 5-20. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief

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description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

7. The disclosure is objected to because of the following informalities: page 1, line 25, "holding...handle" should be changed to --holding one or more circular cutting blades and a handle--; page 5, line 11, "is perspective" should be changed to --is a perspective--; page 5, line 15, "is perspective" should be changed to --is a perspective--; on page 11, line 2, "the connection" should be changed to --connection--; page 12, line 7, "member 38" should be changed to --member 65--; page 14, line 5, states that there are figures labeled 23 and 24, however, there are no such drawings in the instant application.

Appropriate correction is required.

Claim Objections

8. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 37 and 38 have been renumbered 36 and 37, respectively.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 23 and 26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for (1) a rotary trimmer with a cutting blade and guard together removable from a blade carriage (2) a clip that secures the cutting blade to the guard (3) a handle on the blade carriage and (4) an actuator that selectively positions the cutting blade between an operative and inoperative position. The specification does not reasonably provide enablement for a rotary trimmer that has an arcuate pad handle, wherein the handle is elongated and has a hand gripping portion and a neck connecting the hand gripping portion to the blade carriage. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

As noted in paragraph 1 above, applicant elected species I as shown in figure 1. Figures 2 and 3 show structures that have arcuate pads for handles like the one in figure 1. Figure 4 shows a separate species that has a trigger in the neck of an elongated handle. One of ordinary skill in the art would not know how to make and use species I in figure 3 with the elongated handle that has a hand gripping portion and a neck with a trigger as shown in figure 4. The state of the art of using an actuator to selectively position the cutting blade of a rotary trimmer, which has an arcuate pad for a handle, between an operative and an inoperative position is shown in the prior art rejections of Brening and Ridgely below. However, neither ordinary skill in the art nor

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the prior art enables an elongated handle that has a hand gripping portion and a neck with a trigger in combination with a rotary trimmer that has an arcuate handle.

Although the actuator 28 of figure 3 is discussed on page 8, lines 5-13, and is labeled in figure 3, the specification does not disclose how the elongated handle (22, 24, 26), hand gripping portion (24), neck (26) and trigger (28 as shown in figure 4) are combined with the arcuate pad handle. For this reason, the specification does not reasonably provide enablement for a rotary trimmer that has an arcuate pad handle, wherein the handle is elongated and has a hand gripping portion, and a neck with a trigger connecting the hand gripping portion to the blade carriage.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 19-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Brening (957,409). Brening discloses blade carriage a2; cutting blade b; guard a; cutting blade b and guard 1 are together removable by unscrewing the screw in the groove and sliding roller a4 out of the other element labeled a1 in Brening; clip is the screw that secures guard a to blade b; each end of the carriage a2 is a handle because the extensions adjacent to elements a3 have enough surface area to permit a user to grasp the extensions and use them as handles, and alternatively, a10 is interpreted to satisfy the handle limitation; arcuate pad a10 as shown in diagram 1; actuator a10, a6, a4, a1; operative position and inoperative position in column 2, lines 68-83; linear path is collinear with the longitudinal axis of grooves a1 and is oblique to the cutting

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surface shown in figure 2; trigger a10; blade mounting element a5. The handle a10 is “on the blade carriage” because a10 is supported by blade carriage a2 via a, a1, a4 and a3.

13. Claims 19-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ridgely (909,227). Ridgely discloses blade carriage 1; cutting blade 26; guard 13; cutting blade 26 and guard 13 are together removable by sliding element 24 out of elements 4 and sliding element 6 out of element 23; clip 27, 18, 29, 30, 31; elements 9, 10, 12 are a handle because the extensions adjacent to elements 9-12 have enough surface area to permit a user to grasp the extensions and use them as handles, and alternatively, 15 is interpreted to satisfy the handle limitation; arcuate pad 15 as shown in diagram 1; actuator 15, 23, 13; inoperative position in figures 1 and 2; linear path is collinear with the longitudinal axis of slot 23 and is oblique to a cutting surface that is collinear with the bottom edge of blade carriage 1; trigger 15; blade mounting element 25. The handle 15 is “on the blade carriage” because 15 is supported by blade carriage 1 via elements 2, 6, 3, 4, 5.

14. Claims 19-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulz et al (5,711,077), hereafter Schulz. Schulz discloses blade carriage 38A, 38B, 12A, 12B; cutting blade 14; guard 90; cutting blade 14 and guard 90 are together removable by unscrewing clip 20 from element 24; clip 20; handle 36, 38, 40; arcuate pad is the cylindrical outer surface of element 38 not including elements 38A and 38B; actuator 18; operative position in figure 11; inoperative position in figure 10; linear path is collinear with the longitudinal axis of aperture 46 and is oblique to a cutting surface that is a horizontal plane in the figures; trigger 68; blade mounting element 84; neck 40; elongated handle shown in the figures; hand gripping portion 36.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson is cited for an actuator that positions the cutting blade along a linear path with respect to a cutting surface; Dorr discloses a blade guard and cutting blade together removable from the blade carriage, and a trigger; Pierce discloses a handle and an actuator attached to the blade guard.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IH
May 30, 2006



KENNETH E. PETERSON
PRIMARY EXAMINER